

REMARKS

Applicants wish to thank the Examiner for the explanatory note provided in the Examiner's March 20, 2003, Advisory Action, as well as for the courtesies extended in the telephone conversation of March 26, 2003.

Claims 1 to 30 were pending. Without prejudice or disclaimer, Applicants have amended claims 2, 3, 5-10, 23, and 24, as set forth above, and have added new claims 31-50. The amendments and the new claims are supported by the specification and the originally filed claims, and thus raise no issue of new matter.

Specifically, claims 7 and 9 now recite see-through medaka "having in its genome a transgene," which is supported by the term "transgenic" at page 10, lines 7 and 26, and page 30, line 5 of the specification. Similarly, claims 8, 10, 23, and 24 recite that "the transgenic see-through medaka has in its genome said transgene," also supported by the term "transgenic" in the specification.

Further, the phrase "wherein said fluorescent protein is expressed specifically in said organ," in claims 7-10 and 23-24, finds support in the specification at page 9, lines 15-20, describing "the production of a luminescence in a specific organ [of the see-through medaka of the invention] by introducing a hybrid gene being a fusion of a promoter of a gene that expresses organ-specifically and the coding region of the gene encoding a fluorescent protein." Similar support is found at page 10, lines 5-11 and 18-24, page 11, lines 22-27, and in Example 3, pages 27-39.

Also, claims 8, 10, 23, and 24 recite that the transgene "is introduced into the produced see-through medaka, and/or is carried by at least one of the [parent] medaka." This finds support in the specification at page 9, lines 15-20, teaching that the transgene may be introduced into the produced see-through medaka; as well as at page

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10, lines 5-11; page 10 line 25 to page 11, line 1; and page 11, lines 22-27, teaching that the transgene may be carried by at least one of the parent medaka.

Thus, there is no issue of new matter with respect to the amendments.

Moreover, none of the amendments narrow the scope of the original claims as properly interpreted in light of the specification's disclosures under recent Federal Circuit case law. Indeed, all the amendments involve merely cosmetic changes in phraseology for greater clarification.

There is similarly no new matter issue with respect to the new claims which also recite the above-quoted phrases.

CONCLUSION

With the entry of this amendment, claims 1-50 are pending and in condition for allowance. Thus, Applicants earnestly and respectfully request timely issuance of a Notice of Allowance. If the Examiner does not consider the application to be in condition for allowance, Applicants request that she call the undersigned at (650) 849-6611 to discuss the application.

Please grant any extensions of time required and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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